Claims 1, 3-8, 10-15, 17-19, 21-26, and 28-40 are now presented for examination, of which Claims 1, 8, 15, 19, 26, 30 and 36 are independent. Claims 30-40 have been withdrawn from consideration as being directed to a non-elected invention.

First, Applicant notes that the outstanding Office Action does not address the Request For Approval of Drawing Changes that was filed with the Amendment dated June 20, 2001. The Examiner is respectfully requested to advise, in his next Action, whether that Request is approved or not.

Claims 1, 3-8, 10-15, 17-19, 21-27, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,257,119 (Funada) in view of U.S. Patent 5,822,660 (Wen).

Independent Claim 1 is directed to an image processing apparatus including hiding means, which forms second identification information not easily recognizable with the eye and different in form from first identification information relating to a copyright and also not easily recognizable with the eye. The hiding means also sets the second identification information in image data containing the first identification information. The first identification information is formed by a first color signal, and the hiding means comprises color conversion means which performs color conversion of the image data, and forming means which forms the second identification information by a second color different from the first color signal forming the color-converted first identification information in the color-converted image data.

Funada relates to an image processing apparatus which analyzes the color-distribution or color-tone characteristics of an original, and compares the observed characteristics of the original with pre-stored color-characteristic profiles of various types

of documents that may not be copied (banknotes, securities, etc.; see col. 6). If a match occurs between the observed characteristics of the original and one of the pre-stored profiles, the apparatus does not actually prevent or inhibit the operator from making the (presumably illicit) copy of the original, but adds to the copy information that can be used in identifying the machine on which the copy was made (for example, the machine's ID number, or the user's ID number). This information is preferably added in a manner that makes it hard for the additional information to be perceived by the naked eye. *Funada* discusses doing this by forming an image of the additional information in yellow, a color which it is difficult for the naked eye to discern against a white background.

While the Office Action concedes that *Funada* does not anticipate Claim 1, there are a number of assertions in the Action concerning what is taught by *Funada*, with which Applicant finds himself unable to agree. In particular, at page 2, in paragraph 2, the Office Action asserts that "Funada discloses an image processing apparatus for determining the existence of a particular kinds [*sic*; kind] of original images (such as securities, bank notes, confidential patterns and the like that cannot be copies) based on the color tone" but then characterizes this as corresponding to "[first identification information relating to copyright]". Applicant submits that such characterization is incorrect. The last-quoted phrase, which occurs in Claim 1, calls for information that relates to copyright. Applicant strongly asserts that nothing in *Funada* teaches or suggests that the color tone detected by the *Funada* apparatus conveys information "relating to copyright", but only that the apparatus compares the observed color-tone of the original presented for copying with a pre-stored profile for one or more types of documents that it is not permitted to copy. Applicant respectfully points out, however, that the types of documents referred to are ones

whose copying is prohibited based on statutes to prevent counterfeiting, forgery, etc., and the *Funada* apparatus effects this detection purely on the basis of color tone. Applicant submits that the color tone of a document does not in and of itself convey any information relating to any copyright that may subsist with respect to that document.

Moreover, it is noted that Claim 1 also recites that the "first information" is, like the recited "second information", information "not easily recognizable with eye". The color tone of a document, on the other hand, may be very readily recognizable to the unaided eye. For example, the unusual greens that typify U.S. currency are instantly recognizable to the users of that currency. It is submitted that nothing in *Funada* would provide the required clear teaching of the recited "first identification information relating to a copyright and not easily recognizable with eye" recited in Claim 1.

The original Office Action which issued in this application cited *Wen* as providing the teaching of such first identification information, and it is understood from page 4 of the present Office Action that such is still the Examiner's position.

Wen relates to a copy protection method for identifying copied images that have been captured or generated in electronic form. In the *Wen* method, an original such as a photograph is scanned, and the system generates information in electronic form for causing the printing of copy restrictive information as a plurality of continuous pixels, of substantially yellow color, onto the hard copy (Fig. 4; a variant, in which the original is an image acquired by an electronic camera, is shown in Fig. 5). The visibility of the yellow pixels is very low until a cyan illumination is applied to the protected image, and then the copy restrictive information becomes highly visible. (From the discussion of *Wen* in the two Office Actions, it is understood that the Examiner concurs with this reading of *Wen*.)

As understood by Applicant, the outstanding rejection is based on the argument that it would have been obvious to modify the system of *Funada* by utilizing information like the copyright information that is generated and added by the *Wen* apparatus. Applicant submits, however, that even if the two patents are combined, the result would merely be a system like that of *Funada*, in which if an original is recognized as having the color-tone of a type of document that should not be copied, the document is provided with a copyright mark of some kind like that provided by the *Wen* apparatus. Both patents have to do with adding a mark of some kind to an image, and neither is seen to teach or suggest adding one mark in response to detection of a different mark. The only *detecting* noted is that which occurs in the *Funada* system and is discussed above, in which what is detected is the color-tone of the original, rather than a mark like that provided by the *Wen* device. Thus, even if one of ordinary skill received a suggestion, or were otherwise motivated in some fashion, to combine those two patents, the result of such combination would be simply a system capable of adding a copyright mark or the like to an image, as is done by the *Wen* system, and capable also of adding a mark identifying the machine ID, user ID or the like to a copy of an original responsive to detection that the original matches a pre-stored color tone profile. Nothing in such combination, however, would correspond to the hiding means of Claim 1, which adds second information based on detection of the recited "first identification information that is not easily recognizable with eye".

For all these reasons, it is believed to be plain that Claim 1 is allowable over any permissible combination (if any) of *Wen* and *Funada*.

Independent Claims 8, 15, 19 and 26 recite features similar to those recited in Claim 1 and are thought to be patentable for the same reasons.

A review of the other art of record has failed to reveal anything which, in applicant's opinion, would remedy the deficiencies of the art discussed above as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

Attorney for Applicant

Registration No. 28,286

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 178604 v 2